



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/466,640	12/20/1999	LAURA ANNE MAHAN	81395-146	1424

22502 7590 12/22/2004

SMART & BIGGAR
2200 - 650 WEST GEORGIA STREET
BOX 11560, VANCOUVER CENTRE
VANCOUVER, BC V6B4N8
CANADA

EXAMINER

FILIPCZYK, MARCIN R

ART UNIT	PAPER NUMBER
----------	--------------

2161

DATE MAILED: 12/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/466,640

Applicant(s)

MAHAN ET AL.

Examiner

Marc R Filipczyk

Art Unit

2161

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) 2, 7, 12 and 17-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-6, 8-11, 13-16 and 20-44 is/are rejected.
- 7) ☒ Claim(s) 43 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 January 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2161

Response to Amendment

This action is responsive to Applicant's response filed on August 23, 2004.

Amended claims 1, 3-6, 8-11, 13-16 and 20-40 are present for examination, claims 2, 7, 12 and 17-19 remain cancelled and new claims 41-44 are submitted, thus claims 1, 3-6, 8-11, 13-16 and 20-44 are pending.

Oath/Declaration

Applicant has not given a post office address anywhere in the application papers as required by 37 CFR 1.33(a), which was in effect at the time of filing of the oath or declaration. A statement over Inventor No. 3 (K. Forbes) signature providing a complete post office address is required. Appropriate correction is required.

Claim Objections

Claim 43 is objected to because of the following informalities: Its parent claim is a method claim, thus "apparatus" should be replaced with "method", further, "a result" should be replaced with "said result". Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-6, 8-11, 13-16, 20-22 and 29-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vora et al. (U.S. Patent No. 5,623,652) in view of Cahill Jr. (U.S. Patent No. 5,428,784).

Regarding claims 1, 8-11, 20 and 29-32, Vora discloses an apparatus and method for associating information with an object in a file (fig. 2, block 201, Vora), the apparatus comprising a scheduler (fig. 7B, items 727 and 729, Vora) including a component for associating a search key (fig. 2, items 201 and 203, and fig. 7B, keys 726 and 733 with 735, Vora) with the object in the file by tagging the object (fig. 2, items 205 and 207, and fig. 6, box 615 and col. 15, lines 20-27, Vora), wherein said scheduler is operable to schedule a search for local and external information (col. 9, line 56 to Col. 10, line 2, Vora) using said search key for automatic execution at a pre-scheduled time (fig. 7B, key 726 with 735, Vora) by a search interface operable to initiate a pre-scheduled search (fig. 7B, Vora), and associating a search result with the tag (fig. 6, 617, Vora), but does not teach a file of an electronic calendar.

However, Cahill teaches an apparatus and method for linking internet data (information sources) with a file of an electronic calendar (title and abstract, Cahill). Hence, it would have been obvious to a person of ordinary skill in the art at the time the invention was made having Vora's local and external information sources to modify the local information to comprise a file of an electronic calendar information as in Cahill system. One would have been motivated to use a calendar file in Vora because Vora is concerned with improving searching for information in a local and internet network (col. 9, line 56 to Col. 10, line 2, Vora).

Art Unit: 2161

Regarding claims 3, 4, 13 and 14, Vora/Cahill disclose tagging and labeling objects (fig. 2, items 205 and 207, and fig. 6, box 615 and col. 15, lines 20-27, Vora).

Regarding claims 5, 6, 15, 16, 21 and 33, Vora/Cahill disclose scheduling comprises storing (fig. 1, items 11 and 39, Vora) a search key in association with a time of execution at which said search is to be executed (fig. 7B, items 726, 733, 727, 729 and 735, Vora) and identifying said object (figures 2 and 4A, Vora).

Regarding claims 22 and 34, Vora/Cahill disclose the search comprising a search engine (fig. 2, box 207, Vora).

Claims 23-28 and 35-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vora et al. (U.S. Patent No. 5,623,652) in view of Cahill Jr. (U.S. Patent No. 5,428,784) further in view of Stark (U.S. Patent No. 5,935,210).

Regarding claims 23 and 35 Vora/Cahill disclose all of the claimed subject matter as discussed above with respect to claims 20 and 32, including an internet server and a gateway (fig. 1, blocks 63 and 61, Vora), but do not expressly teach a search associated with a universal resource locator (URL). However, Stark discloses a mapping structure of a collection of computer resources (title and fig. 4, Stark) where an URL is associated with a search object (fig. 5, items 120, 122, 124 and 126, Vora). Hence, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Vora/Cahill system

Art Unit: 2161

in view of Stark because Vora/Cahill use an internet server to access local and external sources which could be implemented in view of Stark to associate an URL with an object. One of ordinary skill in the art would have been motivated to map URL with objects to link the desired reference of a search.

Regarding claims 24, 28, 36 and 40, Vora/Cahill in view of Stark disclose running scripts to populate fields of a search engine (fig. 6A, items 202-214, Stark).

Regarding claims 25-27, 37-39 and 41-44 Vora/Cahill in view of Stark disclose URL and hyperlinks (fig. 5, items 142, 144, 150, 152, 154 and 156, Stark).

Response to Arguments

Applicant's arguments filed on August 23, 2004 have been fully considered but they are not persuasive. The arguments and responses are listed below.

Applicant argues on page 12 of the 8/23/2004 response that the post office address of inventor No. 3 (K. Forbes) is the same as her residence address.

Examiner appreciates the comment however an updated or amended version of the Oath or Declaration is required by 37 CFR 1.33(a), which was in effect at the time of filing of the oath or declaration that supports or reflects that which is claimed. As such, the rejection to the Oath/Declaration is maintained.

Art Unit: 2161

Applicant argues on pages 13 and 14 of the 8/23/2004 response that Vora fails to disclose or suggest storing an object associated with a calendar entry in a file of an electronic calendar.

Examiner disagrees. The amended claims now comprising a file of an electronic calendar are not taught by Vora, however they are supported/taught by the system of Vora in view of Cahill. For more information please refer to the rejection above.

Applicant argues on page 14 of the 8/23/2004 response that the Examiner has equated both the collection of items 726, 733 and 735 of Vora and the index of Vora with the applicant's term "search key".

Examiner disagrees. Examiner notes that Applicant did not provide a definition for "search key" in the specification and while it is well known in the computer art, one of ordinary skill in the art also knows it can be applied in a number of different ways. Thus, while the Applicant is correct that the Examiner cited the above mentioned elements as the search key, after reviewing the specification and the Remarks submitted on 8/23/2004 Examiner clarifies that elements 726, 733, 735 of Vora and index incorporate or are used by the search key and elements 201 and 203 of Vora disclose the search key. For more information please refer to the rejection above.

Applicant argues on pages 15-17 of the 8/23/2004 response that Examiner improperly equated the file and tagging of the claimed system.

Examiner disagrees. Similar to Applicant's "search key" argument, Examiner notes that Applicant did not provide a definition for "file" or "tagging" in the specification and while it is

Art Unit: 2161

well known in the computer art and a definition is not required for well known computer terms, one of ordinary skill in the art also knows that those terms can be applied and interpreted in a number of different ways. Again, after closely reviewing the specification and the Remarks submitted on 8/23/2004, Examiner narrows the interpretation of a tag and tagging to a search pointer and pointing respectively, element 203, Vora. Applicant has amended the term file to further mean a file of an electronic calendar, as such, Examiner has issued a new grounds of rejection with additional prior art. Please see rejection above.

Applicant argues on pages 18-20 that Examiner has not established a prima facie case of obviousness in regard to Vora in view of Stark.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, as previously explained by the Examiner, both systems Vora and Stark teach and deal with the use of a network, internet and internet protocols. As such the motivation that Vora teaches URL in view of Stark is the use of the internet protocols.

All the pending claims 1, 3-6, 8-11, 13-16 and 20-44 are rejected.

Conclusion

To expedite the process of examination Examiner requests that all future correspondences in regard to overcoming prior art rejections or other issues (e.g. 35 U.S.C. 112, objections and the like) set forth by the Examiner that Applicants provide and link to the most specific page and line numbers of the disclosure where the best support is found (see 35 U.S.C. 132).

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc R Filipczyk whose telephone number is (571) 272-4019. The examiner can normally be reached on Mon-Fri, 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on (571) 272-4023. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2161

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MF

December 13, 2004


SAFET METJAHIC
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100